

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 7, 2008 has been entered.

Acknowledgments

2. Applicants' argument filed on August 7, 2008 is acknowledged. Accordingly claims 1-33 and 37 remain pending.

Response to Arguments

3. Applicant's arguments filed August 7, 2008 have been fully considered but they are not persuasive.

4. With respect to **claims 1, 12, 23 and 37**, Applicant argues that Stupek does not disclose that the disabling of the first license key is "such that the customer does not have rights to run the previous version of the software." That the purpose of Stupek is to allow access to versions of the software and it does not suggest removing the right to run a preview version of the software. Specifically that Stupek does not suggest the right to run the previous version is removed by the downgrade. That the reasonable

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reading of Stupek is that the previous version of the software is maintained just as the older version of the software is maintained to allow the user to run any such version as needed.

In response, Examiner respectfully disagrees with Applicant's interpretation and mischaracterization of Stupek's invention. First of all it does not make any common sense for any one to upgrade or downgrade only to have two different versions of the same software running in the same system. Secondly what Stupek is talking about is that before upgrade or downgrade of the target computer, the agent may store 115 the older revision levels of the resources on a local hard disk 23. Note that the previous revision version is stored but not in a running state and as a result user can always downgrade to the previous version. The primary purpose of storing the previous version is to allow user access to the stored program and configuration should the owner choose to downgrade to previous version again. The fact that the older revision levels are stored on the local hard disk does not mean that the user have right to run it at that point because the older revision level is not installed or in a running state and its license key has been disabled by the current version's license key and configuration. The previous version is only saved or stored on local hard disk for the purpose of downgrade in the future. In that case, during downgrade the license key and configuration file is retrieved from the local hard disk or registry or whatever place it is stored. And unless the owner carries out a downgrade back to the previous version of the software, the owner has no rights to run the software. Upon request for downgrade or uninstall of the upgraded version of the software, the owner will be left with the older version that was

there prior to the upgrade. This is because the system saved the license key, configuration and some of the component of the previous version on certain registry keys. For more information on how the registry saves or stores the previous version's information and configuration in registry please see Yoo U.S. Patent No. 7,174,549 which discloses system and method for storing product keys.

5. As previously argued and further reiterated herein, it is Examiner's position that the claimed limitation is inherent in software upgrades and downgrades. That is once you upgrade, the right to run the previous version is not available because the license key, the software and the configuration of that version is disabled and saved in the registry. Examiner interprets "downgrade" as replacement or substitution of current version with the old or previous version of the same software. This is because when the software is upgraded or downgraded, the current version that is upgraded or downgraded is replaced or substituted by the version and the current version that is downgraded is no longer in active state or running state and cannot be run at the point. It has been replaced or substituted by the version that is used to upgrade or downgrade it. Because the downgraded version is in inactivated state and the previous or old version is activated the user cannot and does not have rights to run the software that is no longer in active state (the replaced or substituted version). This interpretation is supported by the following Patents: 2004/0015940 to Heisey et al which discloses that an embedded software image is reverted to a previous version; 5,499,357 to Sonty et al, which discloses complete or partial downgrades; 2002/0069316 A1 to Mattison which discloses where each different version of the program or update has a different key ...

which can be updated without going through all revisions in between (0024); 5,843,138 to Evers et al which discloses changing the program permissions, e.g., disabling the permission for the old type and enabling the permission for the updated type; and programming parameters and software according to the upgrade type.

6. It is further the Examiner's position that the reference in Stupek et al that the user always has access to previous versions of the resources is intended when the user wants to downgrade in the future as the next sentence clearly stated: "...maintaining old versions of upgraded resources allows the user to downgrade the resource, if needed in the future." Because the previous version's license key, and configuration are saved or stored in certain registry, that allows the user to downgrade in the future. For this reasons it is inherent that when software is downgraded, the license is replaced with the license of the software version that is being installed and the user has no rights to run the previous version as claimed. The older revision level of the resources are stored on the local hard drive 23 but not in a running state or in an installed state and the user has no rights to run it. Accordingly Stupek does disclose that the disabling of the first license key is "such that the customer does not have rights to run the previous version of the software." As claimed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 5, 7-10,12-13,16,18, 19-21, 23-24, 27, 29-31, and 32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 A1 in view of Stupek Jr. et al Patent No. 5,960,189.

9. As per **claim 1, 12 and 23,** Aldis et al discloses a method comprising:

maintaining a software license bank for a customer, software licenses stored in the software license bank not being associated with specific machines (fig.1 and 11; 0013, 0014, 0018, claim 61); and

accessing a web application to allow a user to automatically obtain a software license for a specific machine from the software license bank, wherein the software license is associated with a first license key (figs.1, 6 and 7; 0014, 0016, 0017, 0018, 0021, 0023, 0061, 0153).

10. What Aldis et al does not explicitly teach is

downgrading software associated with first license key including obtaining a second license key and disabling the first license key, such that the customer does not have rights to run the previous version of the software.

11. Stupek Jr. et al discloses a method comprising downgrading software associated with first license key including obtaining a second license key and disabling the first license key (col. 5, line 65-col. 6, line 45 “Before the packages are installed to the targets, the agent 21 may store 115 the older revision levels of the resources on a local

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disk 23...maintaining old versions of upgraded resources allows the user to downgrade the resource if needed in the future....”, see claim 29;downgrading ...resource from newer version back to old version....).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method of downgrading software associated with first license key including obtaining a second license key and disabling the first license key in view of the teachings of Stupek Jr. et al since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

12. As per **claim 2, 13 and 24**, Aldis et al further discloses the method, wherein the software licenses available from the software license bank depend on a predetermined contract (0022).

13. As per **claim 5, 16 and 27**, Aldis et al further discloses the method, wherein the software license bank contains an unlimited number of licenses for some period of time (fig. 2 and 4, 0078).

14. As per **claim 7, 18 and 29**, Aldis et al further discloses the method, wherein the web application maintains digital records of software licenses, the digital records

indicating rights associated with the software licenses (fig. 2, and 4, 0005, 0015, claim 79).

15. As per **claim 8, 19 and 30**, Aldis et al further discloses the method, wherein web application can be used to adjust the rights associated with the software license (0022, 0069, 0097).

16. As per **claim 9, 20 and 31**, Aldis et al further discloses the method, wherein the web application is used to provide license keys for the software (see figs. 2 and 19, 0077, 0087, claim 40).

17. As per **claim 10, 21 and 32**, Aldis et al further discloses the method, wherein the web application uses role based security (fig.1; 0021, 0022, 0023).

18. **Claims 3, 4, 6, 11, 14, 15, 17, 22, 25, 26, 28, and 33**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 in view of Stupek Jr. et al U.S. Patent No. 5,960,189 and further in view of Watanabe et al U.S. Patent Application Publication 2003/0182146 A1.

19. As per **claim 3, 14 and 25**, both Aldis et al and Stupek Jr. et al failed to explicitly disclose the method, wherein the software license bank stores predetermined dollar amount of licenses.

20. Watanabe et al discloses the method, wherein the software license bank stores predetermined dollar amount of licenses (figs. 3 and 4; 0038).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores predetermined dollar amount of licenses in view of the teachings of Watanabe et al since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

21. As per **claim 4, 15 and 26**, Aldis et al and Stupek Jr. et al failed to explicitly disclose the method, wherein the software license bank stores a predetermined CPU count of software licenses.

22. Watanabe discloses the method, wherein the software license bank stores a predetermined CPU count of software licenses (fig. 3; ...number of license leases...).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores a predetermined CPU count of software licenses in view of the teachings of Watanabe since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

23. As per **claim 6, 17 and 28**, Aldis et al and Stupek Jr. et al failed to explicitly disclose the method, wherein the software license bank stores a predetermined user count of software licenses.

24. Watanabe discloses the method, wherein the software license bank stores a predetermined user count of software licenses (fig. 3; 0027; ...number of customers...).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores a predetermined user count of software licenses in view of the teachings of Watanabe since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

25. As per **claim 11, 22, and 33**, both Aldis et al and Horstmann failed to explicitly disclose the method, wherein the web application stores configuration information for the computers running the licensed software.

26. Watanabe et al discloses the method, wherein the web application stores configuration information for the computers running the licensed software (0032).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the web application stores configuration information for the computers running

the licensed software in view of the teachings of Watanabe et al since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

27. Claims 37, is rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication 2004/0039916 in view of Watanabe et al U.S. Patent Application Publication 2003/0182146 A1.

28. As per claim 37, Aldis et al discloses a method comprising:

maintaining a software license bank for a customer, software licenses stored in the software license bank not being associated with specific machines (fig.1 and 11; 0013, 0014, 0018, claim 61); and

accessing a web application to allow a user to automatically obtain a software license for a specific machine from the software license bank, wherein the software license is associated with a first license key (figs.1, 6 and 7; 0014, 0016, 0017, 0018, 0021, 0023, 0061, 0153).

Upgrading/downgrading software associated with first license key including obtaining a second license key and disabling the first license key (0099; 0100; 0105; 0119), such that the customer does not have rights to run the previous version of the software.

29. What Aldis et al does not explicitly teach is:

wherein the software license bank stores a predetermined dollar amount of licenses.

30. Watanabe et al discloses wherein the software license bank stores a predetermined dollar amount of licenses (figs. 3 and 4; 0035; 0038; ...unit price of license key lease...made under contract...).

Accordingly it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the system of Aldis et al and provide the method wherein the software license bank stores predetermined dollar amount of licenses in view of the teachings of Watanabe et al since the claimed invention is merely a combination of old and known elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

31. Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of

the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is (571) 272-6838. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on **(571) 272 – 6779**.

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/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685
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